

Applicant : John W. Schnell
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Filed : September 17, 2003
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Attorney Docket No. JK01463E
Art Unit: 3726
Examiner: Hong, John C.

REMARKS

Claims 1-50 and 57-62 are pending with claims 1, 12, 23, 33, 41, and 57 being independent. Claims 51-56 have been cancelled. No claims have been amended.

Examiner Interview

Applicants thank Examiner Hong for the courtesy of a telephonic interview with Applicants' representative on July 14, 2006. Applicants' representative and Examiner Hong discussed the rejection of claim 41, but no agreement was reached.

35 U.S.C. § 102(b) Rejection

Claim 41 has been rejected under 35 U.S.C. § 102(b) as being anticipated by EP 1122195 ("the '195 application"). For at least the following reasons, Applicants respectfully request withdrawal of this rejection.

Claim 41 relates to a nail spacing verification assembly for use with a nail loading assembly of a nail gun, and recites "means for determining the spacing between nails of a collated nail strip in the nail loading assembly and allowing the nails to advance when the spacing of the nails in the collated nail strip is determined to be correct for use by the nail gun." This feature of claim 41 is recited using means-plus-function language, under 35 U.S.C. § 112, sixth paragraph. As such, in order to anticipate this limitation, a prior art reference, must "perform the identical function specified in the claim." M.P.E.P. § 2182 (emphasis added). The '195 application does not anticipate claim 41 at least because the device described in the '195 application is unable to perform the claimed function.

The '195 application describes a singulator 20 for sorting agricultural products such as fruits and vegetables. The singulator 20 includes a plurality of parallel conveyors 1-7 that carry the agricultural products at different speeds from a delivery device, such as a vibrator 25, to a further processing area 30, such as an inspection zone. Each track 1-7 includes one or more actuators 9 that move the agricultural objects from one track to another when there is a space available between objects in order to create optimum spacing between objects on each track. To facilitate this spacing and movement of objects, the tracks also include "'object position on a track' detectors (OPOT detectors)

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18" (which the Office Action equates to the claimed means for determining spacing between nails of a collated nail strip). The OPOT detectors 18 detect the position of the agricultural objects on the conveyors. This positional information from the OPOT detectors 18 is fed into a control unit 19 to determine when to move an object from one track to another using actuators 9.

The OPOT detectors 18 of the '195 application do not perform the identical function as the claimed "means for determining the spacing between nails of a collated nail strip in the nail loading assembly and allowing the nails to advance when the spacing of the nails in the collated nail strip is determined to be correct for use by the nail gun." First, the OPOT detectors 18 are not used on nails of a collated nail strip for a nail gun. Rather, the OPOT detectors 18 are used to determine the position of agricultural products on conveyor belts in a singulator. Because the OPOT detectors 18 are used on different types of objects in a different type of system, the '195 application does not perform the identical function as the claimed means.

Second, even accepting solely for the sake of argument that the OPOT detectors 18 could be used on nails of a collated nail strip for a nail gun, the OPOT detectors 18 do not allow "the nails to advance when the spacing of the nails in the collated nail strip is determined to be correct," as recited in claim 41. Rather, the OPOT detectors 18 are used to determine the spacing between objects on the conveyors 1-7 in order to determine when to move objects from one conveyor to another. The objects on the singulator 20 will continue to advance along conveyors 1-7 regardless of the OPOT detectors 18. Thus, the OPOT detectors 18 do not allow the objects to advance when the spacing between the objects is determined to be correct. Because the OPOT detectors 18 do not perform this claimed function, the '195 application does not anticipate claim 41.

The Office Action, at page 2, asserts that the rejection is proper because "the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations" (citing Ex parte Masham, 2 U.S.P.Q.2d 1647 (1987)). However, this quotation ignores the additional legal requirement that a prior art reference must "perform the identical function specified in the claim." M.P.E.P. § 2182. The Office Action, at page 3, also

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asserts that a prior art reference that "performs the function specified in the claim is enough" (citing M.P.E.P. § 2183). However, as explained in detail above, the apparatus disclosed in the '195 application does not perform the function specified in claim 41.

For at least the foregoing reasons, claim 41 is not anticipated by the '195 application.

Allowed Claims

Applicants acknowledge the allowance of claims 1-32 and the indication of allowable subject matter in claims 42-50, which depend from claim 41.

Conclusion

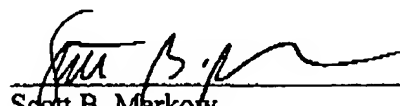
Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.

No fees are believed to be due. Please apply any other charges or credits to deposit account 02-2548.

Respectfully submitted,

Date: _____

8/14/06



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